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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------|
| 10/753,089 | 01/07/2004 | Caidian Luo | 129843.1080 | 5413 |
| 60148 7590 04/09/2007 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201 | | | EXAMINER MARCANTONI, PAUL D | |
| | | | ART UNIT 1755 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 04/09/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|-------------------------------|----------------------------|--|
| Office Action Summary | Application No. 10/753,089 | Applicant(s) LUO ET AL. | |
| | Examiner Paul Marcantoni | Art Unit 1755 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11, and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3-11, and 25-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election without Traverse:

Applicant's election without traverse of Group I (claims 1 and 3-11) in the reply filed on 2/6/07 is acknowledged.

New Matter:

Claims 1 and 3-11 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The terms "greater than about 5%" is new matter in claim 1. Applicants only have support for "between about". It is noted for the record that the terms "between about" is supported in paragraph [0013] but these terms are vague and indefinite because between is not inclusive of the endpoints of a range (only what is between the endpoints) and *about* gives tolerance around the endpoints so the usage of these terms together is contradictory. The use of both terms together for a range are thus conflicting. The examiner suggests that applicant use ---about--- 5% (wt% or vol% ?) and less than about 50 (wt% or vol%?) of the total cellulose fibers incorporated into the matrix. About is also broader in scope than between alone. Between is a term that would narrow the scope of applicants claims.

35 USC 112 Second Paragraph:

Claims 1 and 3-11 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The applicants do not point out and distinctly claim whether they are using weight percent or volume percent with respect to their range of amount of cellulose fibers.

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Applicants are respectfully requested to provide which units they are using (assuming supported by original disclosure) to overcome this rejection.

ODP Rejection:

Claims 1 and 3-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. 6,606,248 B1 and 6,346,146 B1 (both Duselis). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a cement composite comprising a mixture of bleached and unbleached cellulose fibers.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 102:

Claims 1 and 3-11 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Duselis et al. '248 B1 or '146 B1.

Duselis et al. teach a composition comprising a combination or blend of bleached and unbleached cellulose fibers in amounts overlapping applicants' claims (see, for example, Duselis et al. 248 B1, col.5, lines 15-21). Duselis et al. thus anticipate applicants' claims.

35 USC 103 :

Claims 1 and 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duselis et al. ('248 B1 or '146 B1) alone or in view of Cook et al. '726 B2 and Gregerson et al. (EP 263723).

Duselis et al. teach a composition comprising a combination or blend of bleached and unbleached cellulose fibers in amounts overlapping applicants' claims (see, for example, Duselis et al. 248 B1, col.5, lines 15-21). Duselis do not necessarily teach all the types of cellulose fibers claimed by applicants for their invention. Cook et al. (hereafter Cook) teaches examples of cellulose fibers that can be used for cement fiber reinforcement includes radiata pine, spruce, redwood, and douglas fir (see col.3, lines 60-67). It would have been an obvious design choice for one of ordinary skill in the art to use a specific cellulose fiber in Duselis cement/cellulose fiber composition because they are known for that use in the art according to Cook.

Also, Gregerson et al. (hereafter Gregerson) teaches adding cellulose fiber such as bleached or unbleached cellulose fiber to hydraulic binder or cement. Gregerson et

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al. teach conventional cellulose fiber sizes for length are 1.0 mm for bleached cellulose fibers and less than 4 mm for unbleached cellulose fibers (see p.6 under Fibres). This is thus a conventional size range for cellulose fibers and it would have been an obvious design choice for one of ordinary skill in the art to use this cellulose fiber size in cement. Note that this secondary Gregerson was necessary because Duselis did not explicitly teach what fiber sizes he uses for his invention. Nevertheless, it would have been obvious to one of ordinary skill in the art (according to Gregerson) to use conventionally known fiber sizes for cellulose fiber in the Duselis cement/cellulose fiber composition.

Response:

ODP

The examiner maintains the ODP rejection is proper and Duselis does not his range of amounts for his mixture. Duselis '248 B1 teaches cellulose fibers may be bleached, unbleached, or mixtures thereof. Again, Duselis is not limited to any particular ranges but is inclusive of any mixture between bleached fibers and unbleached fibers. This reference is good for all that it teaches and it is inclusive of applicants' claimed mixture.

The applicants argue Kaplan case law noting that the examiner's rejection over Duselis rejection falls under a "dominating" effect in accordance with his case law. The examiner disagrees. A reference is good for all that it teaches and Duselis is inclusive of any mixture of bleached and unbleached cellulose fibers. The applicants are essentially asking the examiner to ignore the teaching of this reference (mixtures of bleached and

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unbleached cellulose fibers) which is inclusive of mixtures and he can not and will not do so.

Duselis 102 and 103:

The applicants acknowledge that Duselis teaches a mixture or combination of bleached and unbleached fibers yet do not teach their specific range of amounts. In rebuttal, the examiner maintains that Duselis is not limited to particular ranges of amounts and teaches any mixtures of bleached and unbleached fibers including from zero to 100 wt% for each cellulose fiber (bleached or unbleached) component under "and mixtures thereof" as taught by Duselis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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